



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/566,826

01/31/2006

Akio Kimura

06067/HG

8012

1933 7590 08/12/2011
HOLTZ, HOLTZ, GOODMAN & CHICK PC
220 Fifth Avenue
16TH Floor
NEW YORK, NY 10001-7708

EXAMINER

VU, JAKE MINH

ART UNIT

PAPER NUMBER

1618

MAIL DATE

DELIVERY MODE

08/12/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/566,826	Applicant(s) KIMURA ET AL.
	Examiner JAKE VU	Art Unit 1618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2011.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8,9,12 and 14 is/are pending in the application.
4a) Of the above claim(s) 8 and 9 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 12 and 14 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/3/11</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of Applicant's Argument filed on 06/13/2011; and Information Disclosure Statement filed on 05/03/2011.

- Claims 8-9, 12 and 14 are pending in the instant application.
- Claims 8-9 have been previously withdrawn from consideration.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12 and 14 rejected under 35 U.S.C. 103(a) as being unpatentable over MORISHIMA et al (WO 02/22131 published on 03/21/2002; wherein US 2004/0097592 is used as a translation) in view of KOIDE et al (JP 07-033650; translation provided) **are maintained** for reasons of record in the previous office action filed on 03/15/2011 and as discussed below.

Response to Arguments

Applicant argues that Morishima et al. do not teach or suggest "polyarylate or a polymer alloy of polyethylene terephthalate and polyarylate.

The Examiner finds this argument unpersuasive, because KOIDE, the secondary reference, teaches a polymer alloy of polyethylene terephthalate and polyarylate, wherein the reason to combine has been discussed in the previous office action.

Applicant argues that Morishima et al. require an addition of a nonionic surfactant or an antioxidant to inhibit the absorption, while the presently claimed invention involves storage in a container for eye drops made of a polymer alloy of polyethylene terephthalate and polyarylate, Morishima et al. and the presently claimed invention completely differ in the means of achieving the object.

The Examiner finds this argument unpersuasive, because Applicant's claim recites "comprising", which is open-ended language, and does not exclude a nonionic surfactant or an antioxidant.

Applicant argues that KOIDE's container made of a pigment and/or U-polymer, wherein a pigment is an essential component and a U-polymer (polyarylate) is an optional component. According to the examples of Koide et al. (stability test using white florescent light), Examples 1 and 2 in Table 1 shows that when vitamin A palmitate is stored in a resin container comprising polyethylene terephthalate containing a pigment, the concentration (residual ratio) of the Vitamin A are respectively 89% and 99%, and the Vitamin A palmitate is stable. Meanwhile, Comparative Example 4 of Table 2 of Koide et al. shows that when vitamin A palmitate is stored in a resin container comprising polyethylene terephthalate containing a U-polymer (polyarylate) but NOT a pigment, the concentration (residual ratio) of the vitamin A is merely 26%, and the Vitamin A palmitate is not stable at all. In other words, the Comparative Example 4 In

Art Unit: 1618

Table 2 of Koide et al. shows that even if Vitamin A is stored in a resin container comprising polyethylene terephthalate containing a U-polymer (polyarylate), the Vitamin A is not stabilized.

The Examiner finds this argument unpersuasive, because KOIDE explicitly teaches using a container comprising of polyethylene terephthalate, a pigment, and/or a U-polymer, such as polyacrylate (see abstract), wherein Applicant rebut this explicit teaching in the abstract of the KOIDE reference with Tables 1 and 2 disclosed by KOIDE in Japanese without any English translation. The Examiner suggests Applicant to completely translate Tables 1 and 2 into English, if Applicant wishes to use Tables 1 and 2 as a rebuttal to an explicit teaching as disclosed by KOIDE. However, by simply analyzing the Japanese Tables 1 and 2 in KOIDE, the Examiner assumes Example 1 without any U-polymer and pigments has a stability of 0% (see Table 1), wherein containers with polyethylene terephthalate, U-polymer and pigments has a stability of 100% (see Table 2), and wherein containers with polyethylene terephthalate and U-polymer has a stability of 26%. The Examiner finds 26% stability with polyethylene terephthalate and U-polymer, such as polyacrylate, to better than 0%.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

Art Unit: 1618

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Telephonic Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAKE VU whose telephone number is (571)272-8148. The examiner can normally be reached on Mon-Tue and Thu-Fri 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jake M. Vu/
Primary Examiner, Art Unit 1618